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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,596	02/27/2004	Dale A. Sather	MS307090.2/MSFTP638US	6817
27195	7590	05/27/2009		
TUROCY & WATSON, LLP 127 Public Square 57th Floor, Key Tower CLEVELAND, OH 44114			EXAMINER CAO, DIEM K	
			ART UNIT 2194	PAPER NUMBER
			NOTIFICATION DATE 05/27/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/788,596

Applicant(s)

SATHER ET AL.

Examiner

DIEM K. CAO

Art Unit

2194

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 1-10 and 27-34 are pending.

Election/Restrictions

1. Applicant's election without traverse of group I, claims 1-10 and 27-34 in the reply filed on 3/13/2009 is acknowledged.
2. Claims 11-26 and 35-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/13/2009.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed to computer program, i.e., software per se, which is not physical "things". It is neither computer component nor statutory process, as it is not "acts" being performed. Such claimed computer program does not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed storage computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of

the computer which permit the computer program's functionality to be realized, and is thus statutory.

Claims 2-10 fail to remedy the deficiencies of claim 1 above, and therefore are rejected under the same ground of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4-8 and 27-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishio (US 7,316,022 B2).

As to claim 1, Nishio teaches a network device interaction system (abstract) comprising:
an application component (application) that seeks to utilize a network device (when printing a document created by an application running on the client, user wants to print data using a printer ... to the network; col. 5, lines 24-25, lines 39-42); and

a configuration system (the automatic driver down-loader/configurator 100 in the application 1 is activated; col. 5, lines 47-49) that automatically configures the network device to operate with the application component (When the user select ... installs the drivers; col. 8, lines 7-18).

As to claim 2, Nishio teaches wherein configuration of the network device comprises loading a driver associated with the device (The application 1 searches a driver database ... the application 1 installs the driver; col. 8, lines 11-18).

As to claim 4, Nishio teaches wherein the device driver is loaded from a local data store (a driver database managed by the client OS; col. 8, lines 11-15).

As to claim 5, Nishio teaches wherein the device driver is downloaded over the Internet (Driver URL ... a storage device of a server on the network; col. 7, lines 28-35).

As to claim 6, Nishio teaches wherein the device driver is received from the network device (A configurator 7 executes the installation of a driver obtained from the printer; col. 4, lines 3-4 and The driver URL can be a URL to the printer; col. 11, lines 12-19).

As to claim 7, Nishio teaches wherein the device driver is retrieved from a computer readable medium (a driver database managed by the client OS; col. 8, lines 11-15).

As to claim 8, Nishio teaches wherein the device driver is retrieved from a computer over a local area network (Driver URL ... a storage device of a server on the network; col. 7, lines 28-35).

As to claim 27, Nishio teaches a method of configuring a network device comprising:
associating a network device with at least one other installed network device (a print
setup window ... a printer selection box; col. 5, lines 19-23 and lines 50-57);

locating a driver component associated with the network device (the application 1
searches a driver database managed by the client OS for a corresponding driver; col. 8, lines 11-
13);

retrieving the driver component (inherent from “the application 1 installs the driver”; col.
8, lines 17-18 or obtaining the driver from a predetermined storage region of a storage device of
a server on the network; col. 7, lines 30-35, and the system installer 1009 obtains the printer
driver stored in the ... client PC; col. 9, lines 59-62); and

loading the driver component to facilitate installation of the network device (the
application 1 installs the driver”; col. 8, lines 17-18 and installs the printer driver in the driver
memory 1004; col. 9, lines 62-63).

As to claim 28, Nishio teaches wherein the at least one other network device is a personal
computer (personal computer; col. 5, lines 25-26).

As to claim 29, Nishio teaches wherein locating a driver component comprises searching
a local data store of the computer (The application 1 searches a driver database ... the application
1 installs the driver; col. 8, lines 11-18).

As to claim 30, Nishio teaches wherein locating a driver component comprises searching a remote server (Driver URL ... a storage device of a server on the network; col. 7, lines 28-35 and the system installer 1009 obtains the printer driver stored in the external memory of the file server 1010; col. 9, lines 59-61).

As to claim 31, Nishio teaches wherein searching a remote server is accomplished over the Internet (inherent from Driver URL ... a storage device of a server on the network; col. 7, lines 28-35).

As to claim 32, Nishio teaches wherein the driver component is retrieved from the network device (A configurator 7 executes the installation of a driver obtained from the printer; col. 4, lines 3-4 and The driver URL can be a URL to the printer; col. 11, lines 12-19).

As to claim 33, Nishio teaches wherein the driver component is retrieved from the associated network device (The application 1 searches a driver database ... the application 1 installs the driver; col. 8, lines 11-18).

As to claim 34, it is the same as the method claim of claim 27 except this is a computer readable medium claim, and is rejected under the same ground of rejection..

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishio (US 7,316,022 B2) in view of Howard et al. (US 6,823,526 B2).**

As to claim 3, Nishio does not teach wherein configuration of the system further comprises setting one or more registry keys.

However, Howard teaches wherein configuration of the system further comprises setting one or more registry keys (The operating system ... in the registry; col. 7, lines 13-24, col. 8, lines 5-26).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made to apply the teaching of Howard to the system of Nishio because Howard teaches in details how the system installs a device driver to use with external device.

8. **Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishio (US 7,316,022 B2) in view of Chiles et al. (US 6,581,157 B1).**

As to claim 9, Nishio does not teach wherein configuration of the network device further comprises updating device firmware to a newer firmware version packaged with the device

driver. However, Chiles teaches wherein configuration of the device further comprises updating device firmware to a newer firmware version packaged with the device driver (col. 1, lines 51-63, col. 6, lines 59-64 and col. 7, lines 28-35). It would have been obvious to one of ordinary skill in the art, at the time the invention was made to apply the teaching of Chiles to the system of Nishio because Chiles teaches a method for updating a memory image in a non-volatile programmable memory in a device, so the device can provide new features and functions (col. 3, lines 36-38 and col. 6, line 59-64).

As to claim 10, Nishio does not teach wherein configuration of the network device further comprises writing a copy of a most recent or current device driver package onto the network device. However, Chiles teaches wherein configuration of the network device further comprises writing a copy of a most recent or current device driver package (col. 6, lines 42-45 and col. 7, line 19-25). Although Chiles does not teach on the network device, Nishio teaches the driver can be maintained in the network device (A configurator 7 executes the installation of a driver obtained from the printer; col. 4, lines 3-4 and The driver URL can be a URL to the printer; col. 11, lines 12-19). It would have been obvious to one of ordinary skill the art, the drive package in the device would be updated to reflect the change of the device. See claim 9 above for reason to apply the teaching of Chiles to the system of Howard.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIEM K. CAO whose telephone number is (571)272-3760. The examiner can normally be reached on Monday - Friday, 7:30AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diem Ky Cao/
Primary Examiner

DC
May 15, 2009